

## REMARKS

The following remarks are made in response to the Office Action of Paper No. 4, dated May 15, 2003. Claims 1-17 are allowable, and claims 22-24 have been objected to as being dependent from a rejected base claim. Claims 18-21 stand rejected and claims 18 and 24 have been amended. Reconsideration of the application is respectfully requested in view of the following remarks.

Claims 18-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dobbin (U.S. Pat. No. 274,198). Specifically, the Office Action states that the Dobbin reference discloses a method comprising providing walls with nails, moving the walls along a guide in a manner so as to expose the heads of the nails from the walls at selected position on the guide and positioning a claw adjacent the selected position of the guide to engage the nail heads and remove the nails from the walls. The Office Action does not state that the nails are removed from the tape but contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of Dobbin to remove nails from tape. Reconsideration of this rejection is respectfully requested.

It is submitted that the Dobbin reference fails to provide a suggestion or teaching to render the claimed invention obvious. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the applicant specification, to make the necessary changes in the recited device. *Ex parte Chicago Rawhide Manuf. Co.*, 226 U.S.P.Q. 438 (BPAI 1934). As amended herein, claim 18 requires the steps of drawing the tape along the guide and bending the tape so as to expose the head of a nail from the tape at a selected position on the guide. The Dobbin reference fails to provide any suggestion related to this step in the method. In the Dobbin reference, the walls containing the nails are rigid and cannot be bent. The walls are conveyed along the table in straight line until they are dropped off the discharge end of the table. In the Dobbin reference, the walls are placed on the table in an inverted position so that the tips of the nails face upward. The walls are then fed over the table to a position under the

vertically reciprocal nail pusher 160 where the nails are pushed back through the wall to expose the nail heads. The method recited in claim 18 eliminates the need for using a pusher 160 because the tape may be drawn along the guide and bent to expose the head of the nail from the tape. For these reasons, claim 18 is patentable over the Dobbin reference.

Claims 19-21 depend from claim 18 and for the same reasons stated above with respect to claim 18, it is submitted that claims 19-21 are patentable.

Claims 22-24 depend from claim 18 and in view of the amendment to claim 18, it is submitted that claims 22-24 are now in a condition for allowance.

### **CONCLUSION**

In view of the foregoing amendments and remarks submitted, it is submitted that the above application is in a condition for allowance and notification to that effect is earnestly solicited at the Examiner's earliest convenience. The Examiner is invited to contact the undersigned by telephone if any other matters require resolution prior to notification of allowance.

Respectfully submitted,  
Thompson Coburn LLP



---

Matthew J. Himich, Reg. #47650  
One US Bank Plaza  
St. Louis, Missouri 63101  
Telephone: 314-552-6299  
Fax: 314-552-7299